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EXAMINER
MADSEN, ROBERT A

ART UNIT	PAPER NUMBER
1761	6

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/919,961	Applicant(s) COLLINS ET AL.
	Examiner Robert Madsen	Art Unit 1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) 17 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-16 and 18-22 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-16,18-22, drawn to method and apparatus for affixing candy pellets to an edible substrate classified in class 426, subclass 87.

   II. Claim 17 drawn to a chocolate tablet with an affixed candy piece, classified in class 426, subclass 87.

2. The inventions are distinct, each from the other because:

Inventions I and II are related as process of making/ apparatus and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process/apparatus as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process/apparatus (MPEP § 806.05(f) & (g)). In the instant case, group II is a product-by-process claim. Therefore, the tablet can be made manually (i.e.. not requiring the process/apparatus of group I)..

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Ray Mandra on May 14, 2003 a provisional election was made without traverse to prosecute the invention of group I, claims 1-16,18-22. Affirmation of this election must be made by applicant in replying to this

Office action. Claim 17 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1,2 ,8,10,11, are rejected under 35 U.S.C. 103(a) as being unpatentable over Uftring (DE 3337405) in view of admission of the prior art, Spatafora et al. (US 6283694 A1) , Powell (US 1987336), and Ackley (US 5768996).

7. Regarding claims 1 ,2, 8,10,11, Uftring teaches a method for decorating cakes, as recited in claim 2, with pellets (item 5) introduced onto a conveyor (item 9), transported to a transfer station (i.e. item 10), arranged in a pattern (at items 11/10), and affixed to the cakes (item 3), which are on a conveyor proximate to the transfer station as recited in claim 11, in the defined pattern (item 3a) (See English Abstracts and Figures). The English Abstracts are silent teaching candy pieces per se and using a feed hopper or carrier bars with pockets as recited in claim 1 and a ramp conveyor as recited in claim 8. Additionally, although it appears that Uftring teaches a vacuum system (in Figure 3) as recited in claim 10, the English Abstracts is silent in teaching a vacuum system per se.

8. With respect to candy pieces, as disclosed in the admission of the prior art, candy pieces are well known desired decorations for baked goods. Therefore, it would have been obvious to select candy pieces as the decoration since it was a desired decoration for baked goods and one would have been substituting one conventional cake decoration for another.

9. With respect to the feed hopper, carrier bars, ramp conveyer, and vacuum system, Spatafora et al. also teach a first conveyor, transfer station utilizing a vacuum, and a second conveyor. However, Spatafora et al. further teach a first conveyor with pockets is preferred because in the method similar to Uftring the conveyors must be run intermittently to provide time to arrange the pattern. As this yields slower production times, Spatafora et al. teach using pockets in the conveyor to align the pieces will improve production rates (Column 1, lines 1-43, Column 1, line 65 to Column 2, line 60, Figures). Powell is relied on as further evidence of a conveyor with pockets for a transfer of an arranged pattern using a vacuum transfer system wherein the pockets are provided on carrier bars, as recited in claim 1(Figures, Column 1, line 35-50, Column 2, lines 8-21, Column 9,lines 9-20). Ackley also teaches a candy pellet conveyor with carrier bar/pockets and is relied on as evidence of the conventionality of utilizing a feed hopper to place the pellets onto the conveyor, as recited in claim 1. Ackley further teaches it is preferred to use a ramp conveyor, as recited in claim 8, in combination with a hopper because one can eliminate extra handling devices for inserting candies into the pockets, which improves efficiency (Column 1, lines 23-30, Column 4, lines 48-Column 6, lines10). Therefore, it would have been obvious to modify

Uftring and include carrier bars with pockets since this a quicker , more efficient way to transfer arranged candy pieces to an edible substrate, and one would have been substituting one means for arranging pieces for another. It would have been further obvious to include a hopper mounted over a ramp conveyor, since Ackley teaches these features will further improve line efficiency, by reducing the amount of handling equipment to insert the pellets onto the conveyor. Furthermore, it would have been obvious to one of ordinary skill in the art to use a vacuum system in the method of Uftring since the abstract states the transfer device picks up the pieces (Derwent Abstract) and Figure 3 resembles a conventional vacuum system used by both Spatafora et al. and Powell to pick up pieces. One would have been substituting one conventional method for picking up and transferring pieces for another.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uftring (DE 3337405) in view of admission of the prior art, Spatafora et al. (US 6283694 A1) , Powell (US 1987336), and Ackley (US 5768996), as applied to claims 1,2,8,10,and 11, further in view of Baker (US 787887).

11. Modified Uftring is silent in teaching a chocolate tablet as an edible substrate. Baker is relied on as evidence of the conventionality of applying patterned candy pieces to a chocolate covered confection in the shape of a tablet, whereas chocolate serves as edible glue(Page 1, lines 8-44, 62-95, Figures). Therefore, it would have been obvious to modify Uftring and a chocolate tablet as a substrate since one would

have been substituting one known circular substrate for another for receiving a chocolate pieces set in a pattern.

12. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uftring (DE 3337405) in view of admission of the prior art, Spatafora et al. (US 6283694 A1) , Powell (US 1987336), and Ackley (US 5768996) further in view of Baker (US 787887) as applied to claim 3, further in view of Okamoto (US 4168321) .

13. Regarding claim 4, Modified Uftring is silent in teaching the chocolate tablet has a recess for receiving the shaped candy piece. Okamoto is relied on the conventionality of providing a candy tablet with a recess to receive chocolate pieces to form a pattern, and further teaches chocolate can be applied to either a convex and/or concave portion of the tablet (Figures, Column 1, lines 10-30, Column 2, lines 1-12). Therefore, to provide a recess in the chocolate tablet to receive the candy piece would have been an obvious matter of choice since Okamoto teaches either a convex or concave portion of a tablet can receive a predetermined pattern.

14. Regarding claims 5 and 6, Uftring is silent in teaching using edible glue, but as discussed above in the rejection of claim 3, Baker teaches attaching patterned candy pieces using chocolate. Therefore, it would have been obvious to include chocolate to affix the candy pieces since this was known to be an acceptable adhesive for affixing candy pieces.

15. Regarding claim 7, Modified Uftring is silent in teaching a chocolate nub that is heated to secure the candy piece. However, as discussed in the rejections of claims

3,5, and 6, Baker teaches it is well known to use melted chocolate to secure a candy piece to a substrate. Therefore, heating a particular portion of the tablet to create melted chocolate for affixing a piece would have been an obvious matter of design since (1) this would eliminate the requirement for additional liquid chocolate handling equipment and additional chocolate application station (2) as discussed in the rejection of claim 1 above it is preferred to minimize the amount of equipment required and stops during the process. One would have been substituting one method of supplying molten chocolate for another for the same purpose: affix a candy piece to a substrate.

16. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uftring (DE 3337405) in view of admission of the prior art, Spatafora et al. (US 6283694 A1) , Powell (US 1987336), and Ackley (US 5768996) as applied to claims 1,2, 8,10,11 above, further in view of Morishita et al. (JP 63196229 A).

17. Modified Uftring is silent in teaching printing on the candy pieces. Morishita et al. are relied on as evidence of printing on the surface of candy pieces (e.g. chocolate) that are affixed to cake (English Abstracts, Figures). Ackley is relied on as evidence of the conventionality of printing on a candy pellet transported on a conveyor comprising pockets (Abstract, Column 1, lines 23-30, Column 4, lines 48-Column 6, lines10). Therefore, it would have been obvious to include a printing step in the method of Uftring since Morishita et al. teach candy pieces with a printed decoration affixed to a cake one would have been substituting one candy piece design for another for the same purpose.

Further, Ackley teaches printing is a conventional step associated with pellets transported a conveyor having carrier bars with pockets.

18. Claims 1, 2,9, 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bibby (5419246) in view of admission of the prior art, Uftring (DE 3337405) and Ackley (US 4672892).

19. Regarding claims 1, 2,9, 12-15, Bibby teaches a method of decorating an edible substrate with edible decorations utilizing a hopper feeding a drum conveyor that is mounted tangent to and above an edible substrate conveyor. Pockets in the conveyor draw a vacuum for holding edible decorations and release the vacuum for transferring edible decorations(i.e. chocolate) of a pre-determined arranged pattern onto an edible substrate (Abstract, Figures, Column 1, line 1 to column 2, line 10, Column 3, lines 8-35, Column 4, lines 25-50, Column 6, lines 7-15). Bibby is silent in teaching candy pellets per se and that that the conveyor comprises carrier bars, as recited in claim 1, or the particular type of edible substrate, as recited in claim 2

20. In the admission of the prior art, it was disclosed that it was well known to apply candy pellets to an edible substrate.

21. Uftring , like Bibby, teach applying chocolate candy pieces to edible substrates, which includes cakes, as recited in claim 2 (English Abstracts, Figures).

22. Ackley also teaches drum conveyor in combination with a vacuum system to position candy in a pre-determined pattern onto a conveyor below the drum. Ackley is relied on evidence of the conventionality of utilizing carrier bars with pockets in order to

transfer candy pellets (Abstract, Column 1, lines 20-25, Column 4, lines 53-68). Therefore, it would have been obvious to modify Bibby and include pellets since it was well known to place candy pellets on an edible substrate and one would have been substituting one known type of candy for another for the same purpose. It would have been further obvious to use a drum conveyor comprising carrier bars since Ackley teaches this system is suitable for transferring candy pellets in a pre-determined arrangement when the drum is mounted above a second conveyor and one would have been substituting one drum design for another for the same purpose: positioning candy pieces in a pre-determined pattern on a second conveyor.

23. Claims 18 , 19, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uftring (DE 3337405) in view of Spatafora et al. (US 6283694 A1) Powell (US 1987336), and Ackley (US 5768996).

24. Regarding claim 18,19,21, Uftring teaches a an apparatus for decorating cakes with pellets (item 5) with a conveyor (item 9), a transfer station (i.e. item 10) for transfer the pieces in an arranged pattern (at items 11/10) and for arranging the pattern, and a cake conveyor, as recited in claim 18 (See English Abstracts and Figures). The English Abstracts of Uftring do not teach using a hopper and carrier bars with pockets as recited in claim 18, or a ramp conveyor as recite in claim 19. Additionally, although it appears that Uftring teaches a vacuum system (in Figure 3) as recited in claim 21, the English Abstracts is silent in teaching a vacuum system per se.

25. Spatafora et al. also teach a first conveyor, transfer station utilizing a vacuum, and a second conveyor. However, Spatafora et al. further teach a first conveyor with pockets is preferred because a Uftring-type of system the conveyors must be run intermittently to provide time to arrange the pattern. As this yields slower production times, Spatafora et al. teach using pockets in the conveyor to align the pieces will improve production rates (Column 1, lines 1-43, Column 1, line 65 to Column 2, line 60, Figures). Powell is relied on as further evidence of conveyors with pockets for a transfer of an arranged pattern using a vacuum transfer system wherein the pockets are provided on carrier bars, as recited in claim 18 (Figures, Column 1, line 35-50, Column 2, lines 8-21, Column 9,lines 9-20). Ackley also teaches a candy pellet conveyor with carrier bar/pockets and is relied on as evidence of the conventionality of utilizing a feed hopper to place the pellets onto the conveyor, as recited in claim 18. Ackley further teaches it is preferred to use a ramp conveyor, as recited in claim 19, in combination with a hopper because one can eliminate extra handling devices for inserting candies into the pockets, which improves efficiency (Column 1, lines 23-30, Column 4, lines 48-Column 6, lines10).

26. Therefore, it would have been obvious to modify Uftring and include carrier bars with pockets since this a quicker , more efficient way to transfer arranged candy pieces to an edible substrate, and one would have been substituting one means for arranging pieces for another. It would have been further obvious to include a hopper mounted over a ramp conveyor, since Ackley teaches these features improve line efficiency, by reducing the amount of handling equipment to insert the pellets onto the conveyor.

Furthermore, it would have been obvious to one of ordinary skill in the art to use a vacuum system in the apparatus of Uftring since the abstract states the transfer device picks up the pieces (Derwent Abstract) and Figure 3 resembles a conventional vacuum system used by both Spatafora et al. and Powell to pick up pieces. One would have been substituting one conventional means for picking up and transferring pieces for another.

27. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uftring (DE 3337405) in view of Spatafora et al. (US 6283694 A1) Powell (US 1987336), and Ackley (US 5768996) as applied to claims 18,19,21 above, further in view of Morishita et al. (JP 63196229 A).

28. Uftring is silent in teaching printing on the candy pieces. Morishita et al. are relied on as evidence of printed candy pieces (e.g. chocolate) affixed to cake (English Abstracts, Figures). Ackley is relied on as evidence of the conventionality of including a printer for printing on a candy pellet transported on a conveyor comprising pockets (Abstract, Column 1, lines 23-30, Column 4, lines 48-Column 6, lines10). Therefore, it would have been obvious to include a printer since Morishita et al. teach the conventionality of candy pieces with a printed decoration affixed to a cake and Ackley teaches a printer is a conventional piece of equipment associated with a conveyor having carrier bars with pockets.

29. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uftring (DE 3337405) in view of Spatafora et al. (US 6283694 A1) Powell (US 1987336), and Ackley (US 5768996) as applied to claims 18,19,21 above, further in view of Bibby (5419246) and Ackley (US 4672892).

30. Modified Uftring is silent in teaching the conveyor is a drum conveyor. Bibby is relied on as evidence of the conventionality of utilizing a drum conveyor with pockets for holding and transferring edible decorations, including chocolate, of a pre-determined arranged pattern onto an edible substrate (Abstract, Figures, Column 1, line 1 to column 2, line 10, Column 3, lines 8-35, Column 6, lines 7-15). Ackley is relied on as the conventionality of using a drum conveyor in combination with candy pellets for positioning the pellets in a pre-determined pattern wherein the conveyor includes carrier bars with pockets (Abstract, Column 1, lines 20-25, Column 4, lines 53-68). Therefore, it would have been obvious to modify Uftring and use a drum conveyor since one would have been substituting one conveyor means for positioning candy pieces in a pre-determined pattern for another for the same purpose: decorating an edible substrate.

Conclusion

A full English translation of Uftring (DE 3337405) will be forwarded to applicant when completed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (703)305-0068. The examiner can normally be reached on 7:00AM-3:30PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703)308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0061.

Robert Madsen
Examiner
Art Unit 1761
June 2, 2003

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